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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,144	11/17/2000	Yosuke Hoi	0505-0714P	5531

7590 08/28/2003

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EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/714,144

Applicant(s)

HOI ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9,11,12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9,11,12 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 3 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/03 has been entered.

### ***Claim Objections***

2. Claims 12 and 14-17 objected to because of the following informalities:
- In line 3 from the bottom of claim 12 Examiner recommends that the phrase "said longitudinal axis" be changed to --said longitudinal axis of said cylindrical relief valve-- to clearly differentiate it from the longitudinal axis of the main gallery and crank shaft, respectively;
  - In line 4 from the bottom of claim 12 "said cylindrical relief" should be changed to --said cylindrical relief valve--.

The remaining claims are indefinite due to their dependency from claim 12.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 4, 5, 9, 11, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 4 and 15. The phrase "a long pipe parallel to said main gallery and a short pipe" in lines 3-4 of the claims is unclear. The phrase reads as if the long pipe is parallel to both the main gallery and a short pipe. Examiner recommends using the phrase set forth in claims 3 and 14 to clearly recite the arrangement of the short pipe. In light of claims 3 and 14 Examiner has interpreted the claim as being directed to an arrangement in which the long pipe is parallel only to the main gallery.

Re: claim 9. The phrase "a L-shaped body" in line 3 from the bottom of claim 9 is indefinite. It is unclear to the Examiner whether the L-shaped body is intended to include or be different from the lead pipe earlier claimed. Examiner has interpreted the claim as the L-shaped body comprising the lead pipe. Also, "a L-shaped body" should be changed to --an L-shaped body-- to maintain consistent claim language.

Claims 5, 11, and 16 are indefinite due to their dependency from one of claims 4, 9, and 15.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP-988538 (JP '538). JP '538 shows in figure 3 a lubricating apparatus capable of being used for a horizontally disposed dry sump engine, comprising: a cylindrical relief valve 78, the cylindrical relief valve having a longitudinal axis disposed in a horizontal direction, the longitudinal axis being disposed in parallel to a longitudinal axis of a main gallery shown in the area of the lead line of element number 50 and a horizontal longitudinal axis of a crank shaft 4 of the engine. It is noted that the crank shaft 4 is shown in figure 1 to be disposed in parallel to the shaft 14 which is shown in figure 3 to be disposed in parallel to the relief valve 78 and the main gallery shown in the area of element number 50.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '538 in view of US Patent 5339776 to Regueiro.

JP '538 shows the use of an oil tank 6a, but does not show the limitation of a strainer, the strainer being provided in the oil tank.

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Regueiro teaches in figure 1 the use of a lubricating apparatus comprising an oil tank 14 and a strainer 15 for straining oil recovered in the oil tank, the strainer being provided in the oil tank.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the oil tank of JP '538 to have included a strainer being provided in the oil tank, as taught by Regueiro, in order to provide a means of separating debris from the oil of the lubrication apparatus.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '538 in view of US Patent 5472360 to Prasse et al.

JP '538 shows in figures 1 and 3 a horizontally disposed engine 2, comprising: a crank shaft 4 having a horizontal longitudinal axis mounted for rotation therein, a main gallery shown in the area of the lead line of element number 50 having a horizontal longitudinal axis extending in a direction parallel to the longitudinal axis of the crank shaft as shown in figures 1 and 3, and a cylindrical relief valve 78, the cylindrical relief valve 78 having a longitudinal axis disposed in a horizontal direction as shown in figure 3, the longitudinal axis being disposed in parallel to the longitudinal axis of the main gallery shown in the area of element number 50 and the longitudinal axis of the crank shaft, but does not specifically disclose that the engine is a dry sump engine.

Prasse et al. teach in col. 1 lines 41-45 the use of a dry sump engine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the engine of JP '538 to have included a dry sump engine, as taught by Prasse et al., in order to provide a means of effectively lubricating a device by using

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gravity to drain lubricating oil down to the bottom of the engine where it may be collected and pumped to a holding tank as taught by Prasse et al. in col. 1 lines 41-45.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '538 in view of US Patent 5472360 to Prasse et al. as applied to claim 12 above, and further in view of Regueiro.

JP '538 shows the use of an oil tank 6a, but does not show the limitation of a strainer, the strainer being provided in the oil tank.

Regueiro teaches in figure 1 the use of a lubricating apparatus comprising an oil tank 14 and a strainer 15 for straining oil recovered in the oil tank, the strainer being provided in the oil tank.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the oil tank of JP '538, as modified, to have included a strainer being provided in the oil tank, as taught by Regueiro, in order to provide a means of separating debris from the oil of the lubrication apparatus.

#### ***Allowable Subject Matter***

11. Claims 3 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. JP-988538 fails to show the relief valve having an L-shaped body. There is no motivation to have modified the relief valve of JP-988538 with a short transverse part (connected to and in communication with the main gallery) to form the L-shape with the long parallel part since it would result in the inclusion of superfluous material.

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12. Claim 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Examiner examined the claims 9 and 11 as being directed to the combination of a lubricating apparatus and a horizontally disposed engine. In light of the treatment of the claims, Examiner notes that with regards to claim 9 since Takahashi et al. teach the use of the claimed relief valve/oil tank arrangement in a vertically disposed engine and since the placing the taught relief valve/oil tank arrangement on its side to reduce a vertical height of the arrangement in a horizontally disposed engine could destroy the function of the engine and also since the Takahashi et al. fail to teach the limitation of the L-shaped body, claim 9 would be allowable if rewritten to overcome the 112 rejection.

13. Claims 4, 5, 11, 15, and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. JP-988538 fails to show the relief valve having an L-shaped body. There is no motivation to have modified the relief valve of JP-988538 with a short pipe forming the L-shape with the long pipe since it would result in the inclusion of superfluous material.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

15. In order to complete the record, it should be noted that no conflict appears to presently exist between the subject matter defined by the instant claims and the subject matter of the claims of applicant's and/or assignee's US Patent 6554104 to Ohyama et al. has been made of record. Accordingly, no double patenting rejection is entered into the instant application. See MPEP 804+ concerning double patenting type of rejections, if necessary. Applicant and/or assignee should maintain this clear line of patentable distinction between the instant claims and the claims of the indicated patent application.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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August 22, 2003

Melody M. Buch  
8/22/03